

REMARKS

The Final Office Action of June 3, 2004, has been received and reviewed. Claims 1-22 are pending in the application of which claims 6-22 stand withdrawn from consideration as being directed to a non-elected invention. Claims 1-5 stand rejected. Applicants propose to amend claims 1 and 5 as set forth herein. All amendments are made without prejudice or disclaimer. Reconsideration is requested.

Rejections under 35 U.S.C. § 102

Claims 1-5 stand rejected under 35 U.S.C. § 102(e) as assertedly being anticipated by Gallo et al. Applicants respectfully traverse the rejections.

Although applicants do not agree that any of the claims are anticipated, to expedite prosecution, applicants propose to amend claims 1 and 5 as set forth herein. As proposed to be amended, independent claim 1 is directed to a method for obtaining information about the capacity or tendency of an oligopeptide of at most 30 amino acids long or a peptide derivative thereof, to regulate expression of a gene comprising the steps of contacting said oligopeptide, or peptide derivative thereof, with at least one cell; and determining the presence of a NF-kappaB/Rel protein in or derived from said at least one cell.

Gallo et al. does not expressly or inherently disclose each and every element of amended claim 1 as required for anticipation. For instance, Gallo et al. does not disclose determining the presence of a NF-kappaB/Rel protein as recited in amended claim 1, but is limited to assays "for the ability [of a preparation] to inhibit HIV replication or expression of HIV RNA or protein," wherein levels of HIV-1 p24 antigen, HIV-1 LTR linked to a reporter gene, HIV-1 derived RNA transcripts or HIV-1 antigens, or SIV p27 antigen are assayed. (*See, Gallo et al.*, Col 21-22). Since Gallo et al. does not expressly or inherently disclose determining the presence of a NF-kappaB/Rel protein, amended claim 1 cannot be anticipated.

Claims 2-5 are not anticipated since they each include the elements of novel, amended claim 1.

Reconsideration and withdrawal of the anticipation rejection of claims 1-5 are requested.

ENTRY OF AMENDMENTS

The proposed amendments to claims 1 and 5 should be entered by the Examiner because they are supported by the as-filed specification and do not any new matter. The proposed amendments should not require a new search since the elements added to claims 1 and 5 were present in claim 15 of the originally filed application, and the proposed amendments further define the element of at least one gene product which was previously searched by the Examiner. Further, since the amendment to claim 1 should remove the 102(e) rejection, the proposed amendment to claims 1 and 5 should place the application in condition for allowance.

CONCLUSION

In view of the foregoing amendments and remarks, claims 1-5 should be in condition for allowance and an early notice thereof is requested. Should questions remain after consideration of the foregoing, the Office is invited to contact the applicants' attorney at the address or telephone number given herein.

Respectfully submitted,



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